

12-16-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #70

IN THE UNITED STATES PATENT AND TI
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EDUCATIONAL MEDIA FOUNDATION,

Opposer,

v.

HISPANIC BROADCASTING
CORPORATION,

Applicant.

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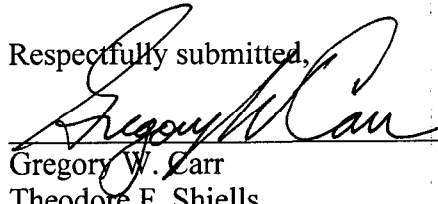
OPPOSITION NO. 122,045

**APPLICANT'S SUBMISSION OF CIVIL COMPLAINT SUPPORTING ITS
UNOPPOSED TO MOTION TO SUSPEND PROCEEDINGS**

Pursuant to the Trademark Trial and Appeal Board's Order dated December 4, 2002, Applicant HISPANIC BROADCASTING CORPORATION ("Applicant" or "HBC") hereby submits the attached copy of the original complaint filed in the civil action instituted on September 12, 2002 in the United States District Court for the Central District of California under CA No-02-7134 (AJWX). A copy of the complaint was inadvertently omitted from Applicant's Consented Motion to Suspend Proceedings filed, on September 23, 2002. Applicant regrets any inconvenience this may have caused.

02 DEC 20 AM 9:30

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gregory W. Carr", is written over a horizontal line.

Date: December 11, 2002

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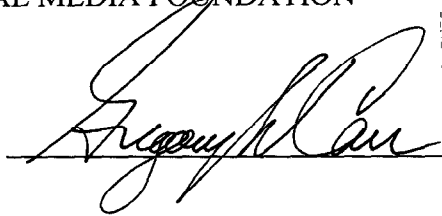
**ATTORNEYS FOR APPLICANT
HISPANIC BROADCASTING CORPORATION**

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S AMENDMENT TO MOTION TO SUSPEND PROCEEDINGS** was served via facsimile and first class mail on this 11th day of December 2002 to the following:

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11 HBC Los Angeles, Inc.; HBC San Diego, Inc.
12 and HBC Broadcasting Texas, L.P.

13
14 UNITED STATES DISTRICT COURT
15 CENTRAL DISTRICT OF CALIFORNIA
16

17 HISPANIC BROADCASTING
CORPORATION, a Delaware
18 corporation; HBC LOS ANGELES,
INC., a California
19 corporation; HBC SAN DIEGO,
INC., a Delaware corporation;
20 and HBC BROADCASTING TEXAS,
21 L.P., a Texas Limited
Partnership

22 Plaintiffs,
23
24 vs.

25 EDUCATION MEDIA FOUNDATION, a
California corporation,
26
27 Defendant.

28 ///

) Case No.: 02-7134 CAS (AJWx)
)
) COMPLAINT FOR DAMAGES AND
) INJUNCTIVE RELIEF ARISING FROM
) TRADEMARK INFRINGEMENT, TRADEMARK
) DILUTION, AND UNFAIR COMPETITION
)
) DEMAND FOR JURY TRIAL

FILED
SEP 12 3 24 PM '02
CLERK U.S. DISTRICT COURT
CENTRAL DIST. OF CALIF.
BY

1 Plaintiffs HISPANIC BROADCASTING CORPORATION; HBC LOS
2 ANGELES, INC., HBC SAN DIEGO, INC., and HBC BROADCASTING TEXAS,
3 L.P. (collectively "Plaintiffs") bring this action against
4 defendant EDUCATIONAL MEDIA FOUNDATION ("Defendant"), alleging
5 causes of action for trademark infringement, trademark dilution
6 and unfair competition, as follows:

7
8 PARTIES

9 1. Plaintiff HISPANIC BROADCASTING CORPORATION is a
10 Delaware corporation having its principal place of business
11 located at 3102 Oak Lawn Avenue, Suite 215, Dallas, TX 75219.

12 2. Plaintiff HBC LOS ANGELES, INC., is a California
13 corporation having its principal place of business located at 655
14 N. Central Ave., Suite 2500, Glendale, California 91203.

15 3. Plaintiff HBC San Diego, Inc., is a Delaware corporation
16 having its principal place of business located at 600 W. Broadway,
17 Suite 2150, San Diego, California 92101.

18 4. Plaintiff HBC Broadcasting Texas, L.P., is a Texas
19 Limited Partnership having its principal place of business located
20 at 1415 N. Loop West, #550, Houston, Texas 77008.

21 5. On information and belief, Defendant Educational Media
22 Foundation is a California corporation doing business within this
23 judicial district and elsewhere.

24
25 JURISDICTION AND VENUE

26 6. This action arises under, inter alia, the Lanham Act, 15
27 U.S.C. sections 1051, et seq. The Court has jurisdiction of this
28 action pursuant to 15 U.S.C. section 1121 and 28 U.S.C. sections

1 1331, 1332 and 1338. The Court has supplemental jurisdiction over
2 the state law claims alleged herein pursuant to 28 U.S.C. 1367.

3 7. Venue is proper in this judicial district pursuant to 28
4 U.S.C. section 1391(b)(2), which provides that a civil action may
5 be brought in any judicial district where a substantial part of
6 the events or omissions giving rise to the claims occurred. In
7 addition, venue is proper in this judicial district pursuant to 28
8 U.S.C. section 1391 (b)(1), which provides that venue is
9 appropriate in any district in which a defendant resides, and 28
10 U.S.C. section 1391 (c), which provides that a defendant that is a
11 corporation shall be deemed to reside in any judicial district
12 within which the corporate defendant has sufficient contacts to
13 subject it to personal jurisdiction if that district were a
14 separate state.

15
16 NATURE OF THIS ACTION

17 8. Plaintiff HISPANIC BROADCASTING CORPORATION ("HBC"),
18 itself and through one or more licensees, is engaged in the
19 business of providing, *inter alia*, entertainment, advertising,
20 broadcasting, and related services via telecommunications
21 channels, including radio and the Internet, as well as via a
22 variety of other mediums (collectively, the "Broadcasting
23 Services"). HBC is also engaged in the business of providing,
24 itself or through one or more of its licensees, a variety of goods
25 promoting the Broadcasting Services, including, *inter alia*,
26 backpacks, sports bags, tote bags, baseball caps, sweatshirts, T-
27 shirts, Frisbees, coffee mugs, and mouse pads (collectively, the
28 "Broadcasting Goods").

1 9. Plaintiff HBC is the owner of the trademark and service
2 mark K-LOVE, which is used in connection with the Broadcasting
3 Goods and Services. Plaintiff HBC, itself and its predecessors
4 and licensees, have collectively used the K-LOVE service mark
5 continuously from at least as early as October 1974 to the
6 present.

7 10. Plaintiff HBC is the owner of federal service mark
8 application Serial Number 75/430,440 for K-LOVE, which was filed
9 February 6, 1998, and California state service mark Registration
10 No. 27817 for K-LOVE, which issued August 13, 1986.

11 11. Plaintiff HBC Los Angeles, Inc. and its predecessors
12 have been at all relevant times the owners and operators of, *inter*
13 *alia*, radio station KLVE-FM, which is located in and operates from
14 the Los Angeles, California metropolitan area.

15 12. Plaintiff HBC Los Angeles, Inc., is licensed to use the
16 K-LOVE mark, with the consent and under the control of Plaintiff
17 HBC, to identify and distinguish the Broadcasting Goods and
18 Services of radio station KLVE-FM.

19 13. Plaintiff HBC San Diego, Inc., is the owner and operator
20 of, *inter alia*, radio station KLQV-FM, which is located in and
21 operates from the San Diego, California metropolitan area.

22 14. Plaintiff HBC San Diego, Inc., is licensed to use the K-
23 LOVE mark, with the consent and under the control of Plaintiff
24 HBC, to identify and distinguish the Broadcasting Goods and
25 Services of radio station KLQV-FM.

26 15. Plaintiff HBC Broadcasting Texas, L.P., is the owner and
27 operator of, *inter alia*, radio station KOVE-FM, which is located
28 in and operates from the Houston, Texas metropolitan area.

1 16. Plaintiff HBC Broadcasting Texas, L.P., is licensed to
2 use the K-LOVE mark, with the consent and under the control of
3 Plaintiff HBC, to identify and distinguish the Broadcasting Goods
4 and Services of radio station KOVE-FM. Additionally, Plaintiff
5 HBC Broadcasting Texas, L.P., formerly used the K-LOVE mark, with
6 the consent and under the control of Plaintiff HBC, to identify
7 and distinguish the Broadcasting Goods and Services of radio
8 stations KOVA-FM and KLTO-FM.

9 17. Plaintiffs and, on information and belief, Plaintiffs'
10 predecessors in interest, have expended, and Plaintiffs continue
11 to expend, substantial efforts and sums advertising and promoting
12 their Broadcasting Goods and Services offered in connection with
13 the K-LOVE mark.

14 18. Plaintiff HBC, through its own efforts, skill and
15 experience, and that of its licensees, has acquired and now enjoys
16 substantial goodwill and a valuable reputation under its K-LOVE
17 mark, which serves to distinguish Plaintiffs' services from the
18 services of others. Plaintiff HBC's K-LOVE mark has become well
19 known and famous, both within the trade and among the relevant
20 consuming public.

21 19. On information and belief, Defendant Educational Media
22 Foundation is engaged in the business of providing one or more of
23 the Broadcasting Goods and Services via at least radio and the
24 Internet.

25 20. On information and belief, Defendant is advertising and
26 soliciting business and listeners for its broadcasting services in
27 the same channels of trade that Plaintiffs use in marketing their
28 Broadcasting Goods and Services offered in connection with the K-

1 LOVE mark, and Defendant is offering its Broadcasting Goods and
2 Services to the same class of purchasers as Plaintiffs offer their
3 Broadcasting Goods and Services.

4 21. Defendant has adopted and used, and continues to use,
5 without Plaintiff HBC's permission, the designation K-LOVE to
6 identify and denote Defendant's Broadcasting Goods and Services.

7 22. Defendant first adopted the infringing designation K-
8 LOVE and commenced use of said designation long after the adoption
9 and first use of the K-LOVE mark by Plaintiff HBC, and long after
10 the issue date of Plaintiff HBC's California state registration of
11 the K-LOVE mark.

12 23. On August 23, 2002, counsel for Plaintiffs sent a cease
13 and desist letter to Defendant, putting Defendant on notice of
14 Plaintiffs' rights in the K-LOVE mark and of Defendant's
15 infringement of Plaintiffs' rights. Nonetheless, Defendant
16 continues to use the infringing designation K-LOVE in connection
17 with its Broadcasting Goods and Services.

18
19 FIRST CLAIM FOR RELIEF

20 .[Violation of Section 43(a) of the

21 Lanham Act, 15 U.S.C. Section 1125(a)]

22 24. Plaintiffs hereby incorporate by reference the
23 allegations of paragraphs 1 through 23, as though fully set forth
24 herein.

25 25. Defendant's use of the designation K-LOVE, as alleged
26 hereinabove, so resembles the distinctive K-LOVE mark of
27 Plaintiffs used in connection with the same Broadcasting Goods and
28 Services, and offered in the same channels of trade and to the

1 same purchasers, that it is likely to cause confusion and/or
2 mistake, and/or to deceive, members of the relevant consuming
3 public and the trade, in violation of Section 43(a) of the Lanham
4 Act, 15 U.S.C. 1125(a), as to: (1) the source or origin of
5 Defendant's radio broadcasting services, (2) the existence of an
6 affiliation, connection, or association between Plaintiffs and
7 Defendant, where none exists, and (3) sponsorship or approval by
8 Plaintiffs of Defendant and its broadcasting services, where none
9 exists.

10 26. The acts of Defendant tend to dilute and reduce the
11 value of Plaintiffs' goodwill under the K-LOVE mark, and to
12 destroy the exclusive association between Plaintiffs and the K-
13 LOVE mark.

14 27. The acts of Defendant constitute the use of a false
15 description and representation of Defendant's broadcasting and
16 related services, which services Defendant has advertised, offered
17 and sold in interstate commerce in violation of §43(a) of the
18 Lanham Act, 15 U.S.C. § 1125(a).

19 28. As a direct and proximate result of the conduct of
20 Defendant in violation of section 43(a) of the Lanham Act, as
21 alleged herein, Plaintiffs have suffered and continue to suffer
22 damages in an amount not yet fully ascertained.

23 29. Plaintiffs have no adequate remedy at law and have
24 suffered and continue to suffer, irreparable harm as a result of
25 Defendant's wrongful acts.

26 30. On information and belief, Defendant will continue the
27 wrongful conduct complained of herein and, unless enjoined, will
28 continue such conduct, to Plaintiffs' irreparable damage.

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1 K-LOVE designation on the basis of a reputation not established in
2 Defendant's own right, and to give Defendant's services and
3 products a salability they otherwise would not have, all at the
4 expense of Plaintiffs.

5 36. The continuing sale of broadcasting services by
6 Defendant under the K-LOVE designation will continue to constitute
7 acts of unfair competition, palming off, unjust enrichment, and
8 misappropriation by Defendants against Plaintiffs, unless enjoined
9 by this Court.

10
11 FOURTH CLAIM FOR RELIEF

12 [Trademark Dilution, 15 U.S.C. section 1125(c)]

13 37. Plaintiffs hereby incorporate the allegations of
14 Paragraphs 1 through 36, as though fully set forth herein.

15 38. Plaintiff HBC's K-LOVE mark is distinctive and famous,
16 within the meaning of 15 U.S.C. section 1125(c).

17 39. Defendant's use of the infringing designation K-LOVE, as
18 alleged above, wrongfully dilutes the distinctive quality of
19 Plaintiff HBC's K-LOVE mark in violation of 15 U.S.C. section
20 1125(c).

21 40. As a direct and proximate result of Defendant's conduct,
22 as alleged herein, Plaintiffs have suffered, and continue to
23 suffer, damages in an amount not yet fully ascertained.

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1 FIFTH CLAIM FOR RELIEF

2 [State Law Trademark Infringement, California
3 Business and Professions Code section 14335]

4 41. Plaintiffs hereby incorporate the allegations of
5 Paragraphs 1 through 40, as though fully set forth herein.

6 42. Defendant's use of the infringing designation K-LOVE, as
7 alleged above, infringes Plaintiff HBC's registered service mark,
8 as evidenced by California Registration No. 27,817, in violation
9 of section 14335 of the California Business and Professions Code.

10
11 SIXTH CLAIM FOR RELIEF

12 [State Law Trademark Dilution, California
13 Business and Professions Code section 14330]

14 43. Plaintiffs hereby incorporate the allegations of
15 Paragraphs 1 through 43, as though fully set forth herein.

16 44. Defendant's use of the designation K-LOVE, as alleged
17 above, constitutes unlawful trademark dilution of Plaintiff HBC's
18 registered service mark, as evidenced by Registration No. 27,817,
19 and Plaintiffs' common law rights in such mark, in violation of
20 section 14330 of the California Business and Professions Code.

21
22 SEVENTH CLAIM FOR RELIEF

23 [State Law Trademark Counterfeiting, California
24 Business and Professions Code section 14320]

25 45. Plaintiffs hereby incorporate the allegations of
26 Paragraphs 1 through 44, as though fully set forth herein.

27 46. Defendant's use of the designation K-LOVE, as alleged
28 above, constitutes unlawful trademark counterfeiting of Plaintiff

1 HBC's registered service mark, as evidenced by Registration No.
2 27,817, in violation of section 14320 of the California Business
3 and Professions Code. In addition to any other allowable remedies
4 at law or equity, Plaintiffs are entitled to the remedies
5 specified in section 14340 of the California Business and
6 Professions Code.

7
8 EIGHTH CLAIM FOR RELIEF

9 [Unfair Competition in Violation of California Business
10 and Professions Code sections 17000, et seq.]

11 47. Plaintiffs hereby incorporate by reference the
12 allegations of Paragraphs 1 through 44, as though fully set forth
13 herein.

14 48. The aforementioned acts of Defendant constitutes
15 unlawful, unfair, fraudulent and misleading business practices in
16 violation of California Business and Professions Code section
17 17200.

18 49. Plaintiffs are thus entitled under California Business
19 and Professions Code section 17203 to injunctive relief and
20 restitutionary relief in the form of disgorgement of Defendant's
21 profits derived from its wrongful acts as alleged herein.

22
23 PRAYER FOR RELIEF

24 WHEREFORE, Plaintiffs pray for judgment in their favor as
25 follows:

26 A. That the Court award Plaintiffs their damages
27 proximately caused by the wrongful acts of Defendant, as alleged
28 above, in a sum not yet ascertained;

1 B. That Defendant be required to account for and pay to
2 Plaintiffs all gains, profits, benefits, and advantages derived by
3 Defendant from its wrongful acts as alleged above;

4 C. That Plaintiffs recover from Defendant their attorneys'
5 fees incurred as a result of Defendant's wrongful acts, as alleged
6 above, including, without limitation, such fees incurred in
7 connection with the instant action, pursuant to 15 U.S.C. section
8 1117;

9 D. That Plaintiffs recover from Defendant their costs of
10 suit incurred in this action;

11 E. That all damages awarded to Plaintiffs be trebled
12 pursuant to 15 U.S.C. section 1117(a) and Section 14320 of the
13 California Business and Professions Code;

14 F. That the Court order Defendant and each of its officers,
15 agents, servants, employees, directors, attorneys,
16 representatives, and related companies and all persons in active
17 concert or participation with any of them, be permanently enjoined
18 from:

19 (1) using in any manner the designation K-LOVE or any
20 colorable imitation or other confusingly similar
21 designation;

22 (2) otherwise infringing upon any trade name or service
23 mark rights of Plaintiffs;

24 (3) otherwise unfairly competing with Plaintiffs, and
25 from committing any other acts which discourage or destroy
26 the public's recognition of Plaintiff HBC's K-LOVE mark as
27 a service mark for Plaintiffs' Broadcasting Goods and
28 Services; and

1 (4) passing off, or inducing or enabling others to sell
2 or pass off, services or products not Plaintiffs' as and
3 for services or products of Plaintiffs;

4 G. That Defendant be ordered to deliver up to the court for
5 destruction, pursuant to 15 U.S.C. section 1118, any and all
6 tangible matter within its possession, custody or control bearing
7 the infringing designation K-LOVE or any confusingly similar
8 designation;

9 H. That Defendants be directed to file with this Court,
10 within thirty (30) days after the entry of any injunction in this
11 cause, a written statement under oath setting forth in detail the
12 manner in which they have complied with that injunction; and

13 I. That Plaintiffs have such other relief as this Court may
14 deem appropriate.

15
16 Dated: September 12, 2002

TISDALE & NICHOLSON, LLP
Guy C. Nicholson
Michael D. Stein

18 -and-

19 Gregory W. Carr
20 Theodore F. Shiells
21 George M. Tompkins
22 CARR LAW FIRM, L.L.P.

23 By: 

Guy C. Nicholson

24 Attorneys for Plaintiffs
25 Hispanic Broadcasting Corporation,
26 HBC Los Angeles, Inc., HBC San Diego,
27 Inc., and HBC Broadcasting Texas,
28 L.P.

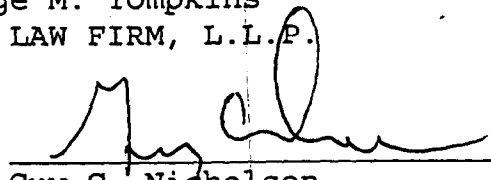
1 DEMAND FOR JURY TRIAL

2 Pursuant to Rule 38 of the Federal Rules of Civil Procedure
3 and Local Rule 38-1, Plaintiffs hereby demand a trial by jury on
4 all issues triable as of right by jury.

5
6 Dated: September 12, 2002 TISDALE & NICHOLSON, LLP
7 Guy C. Nicholson
Michael D. Stein

8 -and-

9 Gregory W. Carr
Theodore F. Shiells
10 George M. Tompkins
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12 By: 
13 Guy C. Nicholson
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Hispanic Broadcasting Corporation,
15 HBC Los Angeles, Inc., HBC San Diego,
Inc., and HBC Broadcasting Texas,
16 L.P.